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TOWNSEND and TOWNSEND and CREW LLP

By: Gigi Hoover

PATENT Attorney Docket No.: 017242-007300US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

MATTHEWS, Susan H.

Application No.: 09/679,139

Filed: October 3, 2000

For: KITS AND METHODS FOR SUSPENDING TOYS OVER A PLAY AREA

Examiner: CONLEY, Frederick C.

**SUBSTITUTE APPELLANT'S BRIEF
UNDER 37 C.F.R. § 1.192**

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Commissioner for Patents
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Sir:

Appellant offers this brief in furtherance of the Notice of Appeal filed on September 19, 2002 in the above-referenced patent application. This brief is submitted in triplicate as required by 37 C.F.R. § 1.192(a). Please deduct the requisite fee, pursuant to 37 C.F.R. § 1.17(c), of \$160 from deposit account 20-1430, and deduct any additional fees from or credit any excess fees associated with the Appeal Brief to such deposit account. Appendix A, attached hereto, contains a copy of all claims pending in this case.

REAL PARTY IN INTEREST:

All right, title, and interest in the subject invention and application are assigned to Camp Kazoo, Ltd., having offices at 602 Park Point Drive, Suite 150, Golden,

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Colorado 80401. Camp Kazoo, Ltd. has since effected a corporate name change to The Boppy Company. Therefore, The Boppy Company is the real party interest.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF THE CLAIMS

Claims 1-23 were originally presented in the application. Claims 4, 13, and 23 have been canceled. Claims 1-3, 5-12, and 14-22 are rejected and are the subject of this appeal. No other claims are pending.

STATUS OF AMENDMENTS

An amendment filed under 37 C.F.R. § 1.116 was mailed on July 22, 2002 to a Final Office Action dated May 22, 2002. An Advisory Action dated August 22, 2002 indicated that the proposed amendment would not be entered. No amendment has been filed in response to the Advisory Action. A copy of the pending claims, prior to entry of the § 1.116 amendment, is provided in Appendix A, attached hereto.

SUMMARY OF THE INVENTION

The present invention provides kits and techniques for presenting items, such as toys, to infants or small children. Application filed October 3, 2000 (Application), page 1, lines 24-25. In one embodiment, as illustrated in Figs. 3 and 4 and associated text on page 1, line 25 through page 2, line 28, the kit comprises a pillow (10) and at least bar (30, 32) that is positionable over the pillow. The pillow comprises a pillow body (12) and at least two attachment mechanisms (26) that are operably coupled to the pillow. The pillow body is constructed of a filler material and includes a medial region (14) and a pair of opposing arms (16, 18) that form a generally open well (20). Preferably, this open well is open to a surface (36) onto which the pillow is adapted to rest such that an infant may lie directly on the surface when lying within the well. The

attachment mechanisms are configured to be attached to the bar. The bar further includes at least one coupling mechanism (40) to permit a toy (42) to be coupled to the bar and held above the pillow. See claims 1 and 18. Advantageously, such a play kit allows the infant to see, reach up, and play with a toy when lying, inclining, or sitting face-up in a supine position on the pillow. Optionally, a pillow cover (22) may be provided in the kit instead of providing a pillow. See claim 9; Application page 2, line 29 through page 3, line 2; Figs. 1 and 2. In this a way, a user already having a pillow may simply place the cover over the pillow and then attach the pillow to the bar.

The present invention also sets forth a method for presenting at least one toy to an infant, as illustrated in Fig. 5 and associated text on page 3, lines 3-8. A pillow is placed onto a surface, at least one bar is attached to the pillow, and a toy is coupled to the bar such that the toy is suspended over the pillow. The pillow comprises a pillow body having a medial region and two opposing arms that define a generally open well that is open to the surface. A child is placed onto the pillow, with the child's head resting on the medial region, with the child's torso resting directly onto the surface, and with the child's feet extending beyond the arms. See claim 22.

ISSUES

I. Whether claims 1-3, 5-6, 9, 11, 12, 14, 15, and 17-22 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 5,546,620, issued to Matthews, in view of U.S. Patent No. 5,930,854, issued to O'Neill et al.

II. Whether claims 7, 8, and 16 are unpatentable under 35 U.S.C. § 103(a) over Matthews, in view of O'Neill et al., and further in view of U.S. Patent No. 4,722,713 issued to Williams et al.

III. Whether claim 10 is unpatentable under 35 U.S.C. § 103(a) over Matthews, in view of O'Neill et al., and further in view of U.S. Patent No. 3,911,512 issued to Plate.

GROUPING OF THE CLAIMS

Pending claims 1-3, 5-12, and 14-22 all stand or fall together based upon independent claim 1.

ARGUMENT

I. Whether claims 1-3, 5-6, 9, 11, 12, 14, 15, and 17-22 are unpatentable over Matthews in view of O'Neil

In the Office Action dated May 22, 2002, claims 1-3, 5-6, 9, 11, 12, 14, 15, and 17-22 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,546,620, issued to Matthews, in view of U.S. Patent No. 5,930,854, issued to O'Neill et al.

Appellant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Matthews or O'Neill et al. references or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references, alone or in combination, teach or suggest all the claim limitations. M.P.E.P. §2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in appellant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Appellant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on at least two of the above requirements.

Firstly, Appellant notes that no motivation or suggestion, either in the cited art references or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to combine the reference teachings so as to produce the claimed invention. Independent claim 1 is directed to a play kit comprising a pillow that in turn comprises a pillow body and at least two attachment mechanisms. The pillow body is constructed of a filler material and includes a medial region and pair of opposing arms that form a generally open well. Importantly, this open well is open to a surface onto which the pillow is adapted to rest to permit a user to lie directly on the surface when lying within the well. Further, at least one bar is positionable over the pillow, wherein the attachment mechanisms are configured to be attached to the bar. The bar includes at least one coupling mechanism to permit a toy to be coupled to the bar and held above the pillow.

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The present invention is an improvement to the support pillow described in the Matthew reference, which is issued to the same inventor as the present invention. Appellant agrees that Matthew discloses a pillow body comprising a filler material and including a medial region and a pair of opposing arms. However, Matthew does not disclose or suggest a bar that is positionable over the pillow to permit a toy to be coupled to the bar and held above the pillow, as even the Examiner concedes. Office Action dated May 22, 2002, page 2, paragraph 2. The Examiner attempts to remedy this deficiency by combining the teaching of Matthews with the disclosure of O'Neill et al. The Examiner states that “[i]t would have been obvious to one having ordinary skill in the art to employ the framework of O'Neill in order to stimulate the infant”. Advisory Action dated August 22, 2002, page 2; Office Action dated May 22, 2002, page 2, paragraph 2. Appellant respectfully disagrees.

The Matthews reference consistently discloses that one or more straps (50, 50', 50'') for directly attaching a toy (52, 54, 56) to a resilient support cushion (12) are attached to the support "in a location whereby the toys **will only be accessible** by the baby when in a **prone position**, such as being only along the noted back position" (e.g. a

back portion of the resilient cushion supports the baby's chest). See col. 1, lines 50-64 (emphasis added); Fig. 7. As clearly explained in col. 4, lines 25-34, of the Matthews reference

*IS A PREFERRED
ARRANGEMENT*

[i]n the disclosed embodiment, straps 50, 50', 50" are positioned to be out of the reach of the baby/infant placed in the device in a supine position. More particularly, it has been determined that when straps 50, 50', 50" are secured to **only the back section** 14 of support cushion 12, preferably a lateral distance of less than about 8 inches from the central axis A-A, and more preferably a lateral distance of less than about 6 inches from the central axis A-A, a baby **cannot** reach toys secured in straps 50, 50', 50" when the baby is positioned in the cushion in a supine position [e.g. a back portion of the resilient cushion supports the baby's head and/or neck].

See also col. 1, lines 50-54; (emphasis added). Matthews further notes, that the straps are positioned **only on a back section** of the support cushion so as not to interfere with the support function of the device. See col. 1, lines 64-67; col. 4, lines 15-18. As such, "[i]t should be noted [again] that the removable toys secured to straps 50, 50', 50" **are not** accessible by the baby when the baby is resting on the cushion in this supine position."

See col. 4, lines 50-53; Fig. 5.

The O'Neill et al. patent, in contrast, describes a toy bar framework (6) where the baby has to clearly lie or sit face-up (e.g. in a supine orientation) to play with toys (34) coupled to the bar framework as the framework and toys are positioned over an annular inflatable support device (4). See col. 4, lines 46-67. In fact, a close examination of this reference reveals that the O'Neill support device having an inner inflatable plastic ring 8 is inflatable to various positions so that an infant may lie diametrically across the device or sit within the device. *Id.* O'Neill states

the apparatus device 4 and framework 6 secured to one another may be used for accommodating young infants in the age region 0-8 months wherein such infants cannot sit up unsupported or should not sit up at all. In this case, the ring 8 may be **inflated to 60-70%**

of its full inflation in order to define a flaccid structure **so that the infant can lie** diametrically across the device.

Id. (emphasis added).

Appellant notes that references can not be arbitrarily combined. There must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 U.S.P.Q. 607 (CCPA 1975). The Examiner citing *In re McLaughlin*, 170 U.S.P. 209 (CCPA 1969) states the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. Advisory Action dated August 22, 2002, page 2. Based on the Matthews and O'Neill et al. references, a person of ordinary skill in the art would not have been motivated to add the toy bar framework of O'Neill et al. over the support cushion of Matthews.

The Matthews reference effectively teaches away from Appellant's invention of a bar that is positionable over the pillow to permit a toy to be coupled to the bar and held above the pillow. The Matthews reference expressly and consistently articulates that the objective of the support cushion is to allow access to the toys **only** when the baby is in a prone position. As such, one of ordinary skill in the art would not have been motivated to employ the toy bar framework of O'Neill, which requires a baby to clearly lie in a supine position to access the toys, over the support cushion of Matthews. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

Conversely, the O'Neill reference effectively teaches away from Appellant's invention. It should be recalled that claim 1 requires the pillow body to be constructed of a filler material and to form a generally open well such that a user may lie within the well. O'Neill expressly states that the only way to lie an infant face-up on the annular support device is to inflate the annular inner inflatable plastic ring by 60-70% of its full inflation. The pillow body of the Matthews reference, in contrast, is constructed

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of a filler material that is incapable of being deflated as is required by O'Neill in order to safely lie the baby in a supine position to access the toys coupled to the bar framework. As such, one of ordinary skill would have been generally discouraged from placing the O'Neill framework over the firm and rigid pillow of Matthews.

Appellant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in the reference teachings themselves, or how knowledge of those skilled in the art, provide a suggestion or motivation to combine the reference teachings so as to produce the claimed invention of claim 1 of at least one toy bar over the pillow, wherein a toy coupled to the bar is held above the pillow. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings). Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the cited art references, or knowledge of those skilled in the art, to combine the reference teachings so as produce the claimed invention of a play kit having at least one bar that is positionable over the pillow to permit a toy to be coupled to the bar and held above the pillow, *prima facie* obviousness of claim 1 (and dependent claims 2, 3, and 5-8) has not been established.

Secondly, even assuming that the Matthews and O'Neill et al. disclosures may be combined (which combination is disputed), the cited art references still fail to teach or suggest all of the limitations of claim 1. For example, both the Matthews and O'Neill references fail to teach or suggest an open well that is open to a surface upon which the pillow is adapted to rest such that the user may lie directly on the surface when lying within the well as claimed in claim 1. O'Neill, in contrast, describes an annular

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support device (4) incorporating a padded base part (14) upon which the infant may lie, kneel, or sit when in an accommodating region (7). See col. 3, lines 63-65. Matthews describes a support (12) having a mat (40) which occupies an interior cavity (30) of the support such that the baby does not contact the floor when within the support. See col. 2, lines 1-8. In fact, the cited art references teach away from the present invention in that the respective devices (i.e. padded base part or mat) prevent direct contact with the surface. In addition, the attachment mechanisms (26) of claim 1 are configured to attach the bar (30, 32) to the pillow (12). The bar in turn includes a coupling mechanism (40) to permit a toy (42) to be coupled to the bar. The straps of Matthews instead are configured to directly attach a toy to a resilient support cushion, not to a toy bar. See col. 4, lines 11-24. As such, *prima facie* obviousness has not been established, and it is therefore respectfully requested that the § 103(a) rejection of independent claim 1 (and dependent claims 2, 3, and 5-8) be withdrawn and the claims be allowed.

Independent claim 9 recites a play kit comprising a pillow cover that is adapted to be placed around a pillow and at least one bar that is positioned over the pillow cover via an attachment mechanism. The pillow cover forms an open well that is open to a surface onto which the pillow cover is adapted to rest such that a user may lie directly on the surface when lying within the well. The bar includes at least one coupling mechanism to permit a toy to be coupled to the bar and held above the pillow cover. Hence, as claim 9 includes similar limitations as those found in claim 1, it is respectfully requested that the § 103(a) rejection of independent claim 9 (and dependent claims 10-12 and 14-17) be withdrawn and the claims be allowed.

Independent claim 18 is similarly directed at a play kit comprising a pillow and a suspensions system. The pillow formed of a filler material defines an open well that is open to a surface onto which the pillow is adapted to rest such that a user may lie directly on the surface when lying within the well. The suspension system is configured to suspend at least one toy over the pillow. As such, *prima facie* obviousness

of claim 18 (and dependent claims 19-21) has not been shown for many of the reasons given above with respect to claim 1 and accordingly the claims should be allowed.

Independent claim 22 recites a method for presenting a toy including, in part, the steps of placing a pillow onto a surface, with the pillow defining a generally open well that is open to the surface, attaching at least one bar to the pillow, coupling a toy to the bar such that the toy is suspended over the pillow, and placing a child onto the pillow with the child's torso resting directly onto the surface. Therefore, it is respectfully requested that the § 103(a) rejection of independent claim 22 be withdrawn and this claim be allowed for many of the reasons given above with respect to claim 1.

II. Whether claims 7, 8, and 16 are unpatentable over Matthews in view of O'Neil and further in view of Williams et al.

Claims 7 and 8 depend from independent claim 1 and claim 16 depends from independent claim 9. As previously argued above in Section I, these claims should be allowable for many of the reasons given above with respect to claim 1.

III. Whether claim 10 is unpatentable over Matthews in view of O'Neil and further in view of Plate

Claims 10 depends from independent claim 9. As previously argued above in Section I, this claim should be allowable for many of the reasons given above with respect to claim 1.

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PATENT

CONCLUSION

Appellant believes that the above discussion is fully responsive to all grounds of rejection set forth in the Final Office Action dated May 22, 2002.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at (415) 273-8317.

Respectfully submitted,



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APPENDIX A

1. (Previously presented) A play kit comprising:
a pillow comprising a pillow body and at least two attachment
mechanisms that are operably coupled to the pillow, wherein the pillow body comprises a
filler material, and wherein the pillow body includes a medial region and a pair of
opposing arms that form a generally open well that is open to a surface onto which the
pillow is adapted to rest such that a user may lie directly on the surface when lying within
the well; and

at least one bar that is positionable over the pillow, with the attachment
mechanisms being configured to be attached to the bar, wherein the bar includes at least
one coupling mechanism to permit a toy to be coupled to the bar and held above the
pillow.

2. (Previously presented) A kit as in claim 1, wherein the bar has a
pair of ends, and wherein the bar is curved so that a middle section of the bar is disposed
above the pillow.

3. (Original) A kit as in claim 1, further comprising another bar, with
the two bars being coupled together so as to both be positioned over the pillow.

4. (Cancelled)

5. (Previously presented) A kit as in claim 1, wherein the pillow
includes four attachment mechanisms, with two of the attachment mechanisms located
near ends of the arms and the other two attachment mechanisms located near the medial
region.

6. (Original) A kit as in claim 1, further comprises at least one toy
coupled to the bar by the coupling mechanism.

7. (Original) A kit as in claim 1, wherein the coupling mechanism comprises a strip of material and a snapping device.

8. (Original) A kit as in claim 1, wherein the pillow further comprises a cover disposed about the pillow body, and wherein the attachment mechanism comprises a loop of material that is coupled to the cover.

9. (Previously presented) A play kit comprising:
a pillow cover that is adapted to be placed about a pillow, wherein the pillow cover includes at least one attachment mechanism, wherein the pillow cover includes a medial region and a pair of opposing arms that form a generally open well that is open to a surface onto which the pillow cover is adapted to rest after the pillow has been inserted into the pillow cover such that a user may lie directly on the surface when lying within the well; and

at least one bar that is positionable over the pillow cover, with the attachment mechanism being configured to be coupled to the bar, wherein the bar includes at least one coupling mechanism to permit a toy to be coupled to the bar and held above the pillow cover.

10. (Original) A kit as in claim 9, wherein the pillow cover includes a zipper to permit the pillow cover to be fastened about the pillow.

11. (Original) A kit as in claim 9, wherein the bar has a pair of ends that are adapted to be placed onto a surface along with the pillow, and wherein the bar is curved so that a middle section of the bar is disposed above the pillow cover.

12. (Original) A kit as in claim 9, further comprising another bar, with the two bars being coupled together so as to both be positioned over the pillow cover.

13. (Cancelled)

14. (Previously presented) A kit as in claim 9, wherein the pillow cover includes four attachment mechanisms, with two of the attachment mechanism located near ends of the arms and the other two attachment mechanisms located near the medial region.

15. (Original) A kit as in claim 9, further comprises at least one toy coupled to the bar by the coupling mechanism.

16. (Original) A kit as in claim 9, wherein the coupling mechanism comprises a strip of material and a snapping device.

17. (Original) A kit as in claim 9, wherein the attachment mechanism comprises a loop of material that is attached to the cover.

18. (Previously presented) A play kit comprising:
a pillow comprising a pillow body that is constructed of a filler material and having a medial region and a pair of opposing arms that define a generally open well, wherein the pillow body comprises a filler material, and wherein the open well is open to a surface onto which the pillow is adapted to rest such that a user may lie directly on the surface when lying within the well; and
a suspension system that is configured to suspend at least one toy over the pillow.

19. (Original) A kit as in claim 18, wherein the suspension system comprises an arrangement of bars and at least one coupling mechanism hanging from the arrangement of bars.

20. (Original) A kit as in claim 19, wherein the suspension system further comprises a set of feet that are configured to rest on a surface.

21. (Original) A kit as in claim 20, wherein the number of feet is four, and wherein the pillow further includes four attachment mechanisms that are spaced apart on the pillow body and are configured to be attached to the arrangement of bars near the feet.

22. (Previously presented) A method for presenting at least one toy, the method comprising:

placing a pillow onto a surface, wherein the pillow comprises a pillow body having a medial region and two opposing arms that define a generally open well that is open to the surface;

attaching at least one bar to the pillow and coupling a toy to the bar such that the toy is suspended over the pillow; and

placing a child onto the pillow, with the child's head resting on the medial region, with the child's torso resting directly onto the surface and with the child's feet extending beyond the arms.

23. (Cancelled)